

### **STATUS OF THE CLAIMS**

Claims 1, 4-9, 12-16, 24, 28, 31-33 and 55-65 are pending in the Application.

Claims 1, 4-9, 12-16, 24, 28, 31-33 and 55 have been rejected by the Examiner.

Claims 56-65 had been previously withdrawn, without prejudice, herein.

Claims 1, 9, 24, 28 and 55 have been amended, without prejudice, herein.

Claims 66-68 have been newly added, herein.

### **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Response After Final**

Entry of this Response is respectfully requested on the ground that this Response places the application in condition for allowance. Alternatively, entry of this Response is respectfully requested on the ground that this Response places the claims in better form and condition for appeal. Furthermore, Applicant submits that any arguments made regarding the claims herein do not require an additional search on the part of the Office, nor do any arguments made herein raise new issues with regard to the patentability of the claims now pending.

### **Claim Objections**

Claim 24 has been objected to because the preamble phrase "A method for ... a historical notable location," should be rephrased. Applicant has amended claim 24 to put the claim in better form and more distinctly claim the subject matter which Applicant regards as the invention.

### **35 U.S.C. 102(b) Rejections**

Claims 9, 12-13, 24, 28 and 55 have been rejected under 35 U.S.C. 102(b) as being anticipated by Weiner (EP 380 727). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).*

Applicant respectfully submits that Weiner fails to teach or suggest each of the elements of independent claims 9, 28 and 55. Specifically, Weiner fails to teach or suggest a memory device utilizing random access memory, as recited in each of claims 9, 28 and 55. Applicant notes that the Examiner, in a prior Office Action dated December 16, 2004,

recognized the lack of any random access memory in the disclosure of Weiner. In the December 16, 2004 Office Action, the Examiner referenced Weiner in a 35 U.S.C. §103 rejection, where the Examiner stated “Weiner fails to teach the memory device comprises a programmable random access memory device (RAM).” (December 16, 2004 Office Action, page 5) Applicant notes that incomplete and/or piecemeal examination is to be avoided to the fullest extent possible (MPEP 707.07g). As such, rejections that flip-flop the presence or absence of claim elements do not constitute proper examination.

Applicant also respectfully submits that Weiner fails to teach or suggest a portable device capable of loading information onto the memory device, and storing the loaded information internally within the memory device, as recited in amended claims 9, 24, 28 and 55. As explained in the disclosure of Weiner, the storage device “is a read-only memory (ROM), since the message is a fixed one for the particular article displayed.” (Weiner at col. 4, lines 52-55). Furthermore, the storage device of Weiner not only lacks the RAM necessary for uploading and storing data therein, but Weiner is also completely silent on how such data might be uploaded. There is no mention of how the digitally stored recordings ever get into the storage device, no less a portable device capable of loading such information onto the programmable RAM of the memory device. Therefore, Weiner ***does not and cannot*** disclose a system comprising a portable device capable of loading information onto the memory device, and storing the loaded information internally within the programmable RAM of the memory device, and in fact clearly teaches away from the present invention.

Support for the current amendments made to Claims 1, 9, 24, 28 and 55 can be found generally within the Specification of the present Application, and specifically at page 6, lines 2-10, wherein it states:

Portable memory reading device 5 may comprise a special purpose computer, a portable general purpose computer such as a laptop computer, or any other type of portable computerized device, including a hand-held portable computer, a wireless communications device, and/or a smart wireless communications device, that has the ability to read, receive, and/or display all or a portion of the information stored on memory devices 2B-3B when placed at locations 2-3 or in close proximity to memory devices 2B-3B. Typically, portable memory reading device 5 will have an integrated means of reading, receiving, and/or writing information from or to memory devices 2B-3B.

Additionally, new claims 66-68 are equally supported by the above disclosure, in combination with the support granted to the original claims as originally filed and previously amended.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection of claims 9, 24, 28 and 55, as Weiner fails to teach or suggest either the presence of RAM in the memory device, and further fails to teach or suggest a portable device capable of loading information onto the memory device, and storing the loaded information internally within the memory device, as recited in claims 9, 24, 28 and 55. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections of claims 12 and 13, as these claims ultimately depend on a patentably distinct, base claim 9.

### **Claim Rejections Pursuant to 35 U.S.C. §103**

Claims 1, 4-8, 14-16 and 31-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Assisi (U.S. Patent No. 5,696,488). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

For the same reasons as set forth above, Weiner fails to teach or suggest a portable device capable of loading the information onto the memory device, and storing the information internally within the random access memory of the memory device, as recited in amended claims 1, 9 and 28. Likewise, Assisi also fails to teach or suggest a portable device capable of loading the information onto the memory device, and storing the information internally within the random access memory of the memory device. In fact, Assisi not only does not describe how the information is loaded on the storage device, but lacks any disclosure of a storage device having programmable RAM therein.

Additionally, Assisi fails to teach or suggest the portable device directly retrieving the information from the memory device. Applicant submits the disclosure and sole drawing of Assisi requires three separate and essential units for retrieval of the information: A computer having therein a storage device 6; a transmitter/receiver device 2; and a communication apparatus 3 (Assisi, Fig. 1). Thus, for a user of the communication apparatus to retrieve information from the storage device, a signal is sent from the communication apparatus at a first location to the transmitter/receiver device at a second location, which transmits the request to the computer having therein the storage device at a third location. This is a different system than that of the presently claimed invention of at least claims 1 and 28, as the present invention does not require a transmitter/receiver device positioned in a location *separate from the memory device and/or portable device*. As further explained by Assisi, "A computer is preferably provided for control of communication between the communications device and the transmitter/receiver device or the storage device." (Assisi col. 1, lines 63-65) No such computer, separate from the portable device and the memory device, is needed for

controlling communications between the portable device and the memory device in the present invention. Thus, the disclosure of Assisi does not teach or suggest: a) a memory unit having programmable RAM; b) a portable device capable of loading the information onto the memory device, and storing the information internally within the random access memory of the memory device; or c) a portable device that retrieves the information directly from the memory device via a non-permanent proximity link.

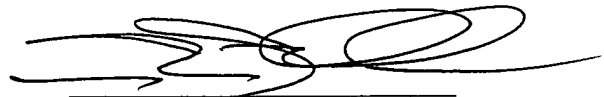
Accordingly, Applicant submits at least claims 1 and 28 are patentably distinguishable over Weiner and Assisi, at least because neither reference, either separately nor in combination teach or suggest a portable device capable of loading the information onto the memory device, and storing the information internally within the random access memory of the memory device, as recited in amended claims 1 and 28. Applicant further submits that claims 4-8 and 31-33 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base claim 1 or 28.

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## **Conclusion**

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'THOMAS J. MCWILLIAMS', written over a horizontal line.

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